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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ C.O.(COMM.IPD-PAT) 3/2021

**DR. REDDYS LABORATORIES
LIMITED & ANR.**

..... Petitioners

Through: Mr. J. Sai Deepak, Mr. G. Nataraj, Mr. Shashi Kant Yadav and Mr. Rahul Bhujbal, Advs.

Versus

THE CONTROLLER OF PATENTS & ORS Respondents

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advs. for R-1
Mr. Ashok Aggarwal, Sr. Adv with Mr. Sanjay Kumar, Ms. Arpita Sawhney, Mr. Arun Kumar Jana, Ms. Meenal Khurana, Mr. Harshit Dixit and Mr. Priyansh Sharma, Advs. for R-2

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

JUDGMENT (ORAL)

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03.08.2023

IA 5896/2023 (Section 10 of the CPC)

1. This judgment adjudicates IA 5896/2023, preferred by Respondent 2 Boehringer Ingelheim International GmbH (“Boehringer”, hereinafter) under Section 10¹ of the Code of Civil

¹ **10. Stay of suit.** – No Court shall proceed with the trial of any suit in which the matter in issue is also directly and substantially in issue in a previously instituted suit between the same parties, or between parties under whom they or any of them claim litigating under the same title where such suit is pending in the same or any other Court in India having jurisdiction to grant the relief claimed, or in any Court beyond the limits of India established or continued by the Central Government and having like jurisdiction, or before the Supreme Court.



Procedure, 1908 (CPC), seeking stay of proceedings in the present revocation petition CO (Comm. IPD-PAT) 3/2021, preferred by the petitioners under clauses (a), (d), (e), (f), (h), (i), (k) and (m) of Section 64² of the Patents Act 1970.

2. Three distinct issues arise for consideration in the present petition. They may be delineated thus:

(i) Is Section 10 of the CPC applicable to revocation petitions preferred under Section 64 of the Patents Act? In

Explanation. – The pendency of a suit in a foreign court does not preclude the Courts in India from trying a suit founded on the same cause of action.

² 64. **Revocation of patents.** –

(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, be revoked on a petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say, -

(a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;

(d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;

(e) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in Section 13;

(f) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim;

(h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;

(i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

(k) that the subject of any claim of the complete specification is not patentable under this Act;



other words, can a revocation petition be treated as a suit for the purposes of Section 10 of the CPC?

(ii) Assuming that the answer to issue (i) is affirmative, has COMS 5/2021, filed by Respondent 2 before the High Court of Himachal Pradesh, on the basis of which the present application has been moved, been instituted prior in point of time to the present revocation petition, as required by Section 10 of the CPC?

(iii) Is a case for grant of the prayer in this application made out on merits?

3. It would be advantageous to, in the first instance, address the second question, which is whether COMS 5/2021 was instituted prior in point of time to the present revocation petition CO (Comm. IPD-PAT) 3/2021. For this purpose, it is necessary to note certain relevant dates, regarding the institution and prosecution of the present revocation petition as well as the institution and prosecution of COMS 5/2021.

4. The revocation petition CO (Comm. IPD-PAT) 3/2021 was filed by the petitioners electronically, across the e-filing portal of this Court, on 16 October 2021. The petition seeks revocation of IN 268846 (“IN’846”, hereinafter), granted to Respondent 2 in respect of “Glucopyranosyl-substituted Benzenol derivatives, drugs containing

(m) that the applicant for the patent has failed to disclose to the Controller the information required by Section 8 or has furnished information which in any material particular was false to his knowledge;



said compounds, the use thereof and method for the production thereof”, which bears the INN nomenclature Empagliflozin, and is used as an anti-diabetic drug. As 16 October 2021 was a Court holiday, the petition was admittedly scrutinized by the Registry of this Court and registered on 21 October 2021. It came up for hearing before this Court on 22 October 2021, on which date notice was issued, returnable on 10 January 2022.

5. As against this, COMS 5/2021 was filed by Boehringer, asserting IN’846 and alleging infringement, by the petitioners, of the said patent. The suit was filed by Boehringer before the High Court of Himachal Pradesh on 19 October 2021, i.e. three days after the present revocation petition was electronically filed by the petitioner before this Court. COMS 5/2021 came up for hearing before the High Court of Himachal Pradesh on 20 October 2021, on which date *ex parte* stay was granted by the High Court.

6. Boehringer filed a second suit against the petitioners, being COMS 7/2021 on 21 October 2021, in which, too, stay was granted by the High Court of Himachal Pradesh on 25 October 2021.

7. Mr. Ashok Aggarwal, learned Senior Counsel for Boehringer submits that the issues in controversy in the present revocation petition CO (Comm. IPD-PAT) 3/2021 and in COMS 5/2021 i.e. the suit filed by Boehringer against the petitioners before the High Court of Himachal Pradesh, are not only overlapping but are identical. He submits that, in the written statement filed by the petitioners, as the



respondents, before the High Court of Himachal Pradesh in COMS 5/2021, the petitioner had questioned the validity of IN'846, which is precisely the foundation and the basis of the present revocation petition, and the ground on which revocation of IN'846 is sought. He submits that, in fact, the written statement filed by the petitioner before the High Court of Himachal Pradesh in COMS 5/2021 is a verbatim reproduction of the present revocation petition CO (Comm. IPD-PAT) 3/2021. In these circumstances, Mr. Aggarwal submits that, on merits, a clear case for stay of the present revocation proceedings, awaiting the outcome of COMS 5/2021, presently pending in the High Court of Himachal Pradesh, is made out, *inter alia*, to avoid the possibility of conflicting decisions.

8. Before proceedings to merits, however, as already noted, two preliminary issues arise for consideration.

I. Was the revocation petition institute prior, or later, in point of time, to the suit?

9. The first issue that is requested to be addressed is whether COMS 5/2021 was, in fact, instituted by Respondent 2 in the High Court of Himachal Pradesh prior in point of time to the institution of the present revocation petition by the petitioners before this Court – assuming the revocation petition can be treated as a suit, which I would address later.

10. The pivotal expression in Section 10 of the CPC is “instituted”. Section 10 proscribes a Court from proceeding with trial of any suit in



which the matter in issue is directly and substantially in issue in a previously *instituted* suit between the same parties. The applicant and the respondent must have instituted suits against each other and the suit instituted by the applicant must be previous in point of time to the suit instituted by the respondent.

11. In order to demonstrate that COMS 5/2021, though filed later than CO (Comm. IPD-PAT) 3/2021, must be treated as having been instituted prior in point of time, Mr. Aggarwal advances the following submissions:

(i) There is a distinction between institution of a suit and filing of a plaint.

(ii) Order IV Rule 1(1)³ of the CPC stipulates that a suit shall be instituted by presenting a plaint to the Court or to the Officer appointed in that behalf by the Court.

(iii) Order IV Rule 1(3), however, clarifies that a suit shall not be deemed to be duly instituted unless it complies with requirement of Order IV Rule 1(1) and Order IV Rule 1(2).

(iv) The requirement envisaged by Order IV Rule 1(2) is compliance, by the plaint, of the provisions of Order VI and

³ **1. Suits to be commenced by plaint. –**

(1) Every suit shall be instituted by presenting a plaint in duplicate to the Court or such officer as it appoints in this behalf.

(2) Every plaint shall comply with the rules contained in Orders VI and VII, so far as they are applicable.

(3) The plaint shall not be deemed to be duly instituted unless it complies with the requirements specified in sub-rules (1) and (2).



Order VII of the CPC.

(v) It is only, therefore, after the suit has been found to pass scrutiny of Orders VI and VII of the CPC, that it can be said to be duly instituted.

(vi) Mere filing of the plaint electronically cannot, therefore, be treated as institution of the suit.

(vii) The suit would be deemed to be instituted, therefore, only where, after the plaint is filed and it is registered, the Court takes cognizance of the plaint, finding it to have passed preliminary scrutiny of Orders VI and VII of the CPC.

(viii) Without prejudice, and at the very earliest, the suit can be treated as having been duly instituted only when it is registered by the Registry of the Court.

(ix) As such, mere filing of the suit prior to registration would not constitute “institution” of the suit. In the present case, as the suit was electronically filed on 16 October 2021, which happened to be a Court holiday, it was scrutinized by the Registry only on 21 October 2021, the next working day. It could not, therefore, be said to have been instituted at any point of time prior to 21 October 2021, though, in Mr. Aggarwal’s submissions, it was actually instituted only on 21 October 2021, when the Court took cognizance of the petition and issued notice thereon.



(x) As such, COMS 5/2021 was instituted by Boehringer in the High Court of Himachal Pradesh on 19 October 2021, which stood instituted prior to the institution, by the petitioners, of the present revocation petition.

12. Mr. Aggarwal also sought to place reliance, in this context, on the E-Filing Rules of the High Court of Delhi 2021 (“the E-Filing Rules”). However, as Mr. J. Sai Deepak, learned Counsel for the petitioners correctly points out, the E-Filing Rules were notified only on 22 February 2022, to come into effect from 1 March 2022. The opening recitals in the E-Filing Rules clearly state that they would come into force on the date notified by the High Court. Inasmuch as the E-Filing Rules were notified to come into force with effect from 1 March 2022, *vide* Notification of 22 February 2022, there can obviously be no question of any application of the said Rules to the present case in which the revocation petition was electronically filed on 16 October 2021, registered on 21 October 2021 and taken up for hearing on 22 October 2021. I do not, therefore, deem it necessary to advert to the E-Filing Rules of this Court, as they are not applicable.

13. In response to the submissions of Mr. Aggarwal, Mr. J. Sai Deepak would seek to contend that the date of institution of a suit is the date of its presentation. Apropos Order IV Rule 1(3) of the CPC, he submits that, even if a suit as presented is found to be defective vis-a-vis Order VI or Order VII of the CPC, once the defects are cured, the institution of the suit would date back to its original filing. As such, he submits that institution of the present revocation petition –



assuming it, for the sake of arguments, to be a suit at all – would be 16 October 2021, and not either 21 October 2021 or 22 October 2021.

14. Having heard Mr. Aggarwal and Mr. Sai Deepak at length on this issue, I am inclined to hold that the institution of the present revocation petition has to be taken as having taken place on 16 October 2021, and not on any later date.

15. One does not need to look outside the CPC, to know when a suit is to be treated as having been instituted. Order IV Rule 1(1) of the CPC clearly states that every suit shall be instituted by presenting a plaint in duplicate to the Court or such officer as it appoints in this behalf. Presentation of a plaint to a competent officer authorised by the Court is, therefore, *ipso facto* institution of a suit within the meaning of the CPC. This is made clear when one proceeds to Order IV Rule 2⁴, which envisages the Court causing the particulars of every suit to be entered in a book to be kept for the purpose called the register of civil suits. In other words, registration of a civil suit, under Order IV Rule 2 of the CPC takes place only after institution of the suit under Order IV Rule 1 of the CPC, as already occurred. Order IV Rule 2 of the CPC is, therefore, a complete answer to Mr. Aggarwal's contention that a suit is to be treated as having been instituted only when it is registered. A juxtaposed reading of Order IV Rule 1 and Order IV Rule 2 of the CPC makes it abundantly clear that the suit is instituted under Order IV Rule 1 when it is presented to the competent

⁴ **2. Register of suits.** – The Court shall cause the particulars of every suit to be entered in a book to be kept for the purpose and called the register of civil suits. Such entries shall be numbered in every year according to the order in which the plaints are admitted.



officer and that registration of the suit takes place only thereafter under Order IV Rule 2 of the CPC.

16. Insofar as Order IV Rule 1(2) and (3) of the CPC are concerned, they, no doubt, provide that a plaint shall not be deemed to be duly instituted unless it complies with the requirement of Order IV Rule 1(1) and Order IV Rule 1(2) of the CPC. When one reads Order IV Rule 1(3) alongside Order IV Rule 1(1) and Order IV Rule 1(2), the position that emerges is that, while institution of the suit takes place *ipso facto* on presentation of the plaint, the plaint itself is required to comply with the Rules contained in Orders VI and VII of the CPC. In the event that the plaint does not comply with the said provisions, Order IV Rule 1(3) does not deem the plaint to be duly instituted. That does not, however, mean that the date of institution of the suit gets postponed to the date when compliance with Orders VI and VII of the CPC takes place. All it means is that, while the suit stands instituted on the date when the plaint is presented, the suit has to comply with Orders VI and VII of the CPC. If there is any defect in the suit, on curing or rectification of the defect, Order IV Rule 1(1) would come into play and the suit would stand duly instituted on the date when it was presented to the competent officer appointed by the Court. The submission of Mr. Aggarwal which would seem to be that the date of institution of the suit would stand postponed to the date when the suit is found to comply with Order VI or Order VII of the CPC cannot, therefore, be accepted on a plain reading of this statute.

17. That said, in the present case, this controversy does not really



arise, as it is nobody's case that the revocation petition as presented by the petitioners on 16 October 2021 did not comply with Orders VI and VII of the CPC. In fact, this may be one of the issues, which would also dovetail into the second question that arises for consideration as to whether the revocation petition can at all be treated as a suit.

18. Be that as it may, even if it were to be assumed that a revocation petition can be treated as a suit, in the case of a revocation petition, quite clearly, institution would take place on the date when the revocation petition is presented to the competent officer. There is no question, therefore, of the date of presentation of the revocation petition in the present case being affected either by Order IV Rule 1(2) or Order IV Rule 1(3) of the CPC.

19. Prior to the notification of 2021 E-Filing Rules, electronic filing of petitions in this Court were governed by the provisions, in that regard, contained in the Delhi High Court (Original Side) Rules, 2018 ("the Original Side Rules") read with the Annexures thereto. Chapter IV of the Original Side Rules deals with "Presentation of Pleadings, Other Documents and Maintenance of Case Files". Rule 1(1)(a) thereof reads thus:

"1. Presentation at the counter. –

(a) *Subject to Annexure C to these Rules*, all plaints, petitions, applications and documents either original or copies shall be presented by the plaintiff, petitioner, applicant, defendant, respondent or filing party in person/his duly authorized agent/an Advocate, duly appointed by him for the purpose, at the filing counter. All such documents filed in Court shall be accompanied by an index containing their details and page numbers. Noncompliant pleadings/documents with this Rule will



result in return with objections by the Registry of the filed pleading/documents.”

Thus, physical filing of complaints, or petitions, at the filing counter of the Registry was made *subject to* Annexure C to the Original Side Rules. In the backdrop of the present dispute, this provision is of pre-eminent significance.

20. Annexure C to the Original Side Rules contains the “Practice Directions for Electronic Filing(E-filing) in the High Court of Delhi”, in respect of which Rule 1 in Chapter XXVII of the Original Side Rules (titled “E-FILING”) also provides – though it was not strictly necessary – thus:

“**1. E-Filing.** – ‘Practice Direction(s) for Electronic Filing (E-Filing) in the High Court of Delhi’ *shall stand incorporated by inclusion* in these Rules and are annexed hereto as Annexure-C.”
(Emphasis supplied)

Thus, the Practice Directions for E-Filing (“the Practice Directions”, hereinafter) are statutorily *incorporated by reference* in the Original Side Rules. Incorporation by reference, a legislative device more used to incorporate, into a later statute, the provisions of an earlier statute, stands authoritatively explained by Lord Esher, M.R. in *In re. Wood’s Estate*⁵, thus:

“It is to put them into the Act of 1855, just as if they had been written into it for the first time. If a subsequent Act brings into itself by reference some of the clauses of a former Act, the legal effect of that, as has often been held, is to write those sections into the new Act just as if they had been actually written in it with the pen, or printed in it, and, the moment you have those clauses in the later Act, you *have no occasion to refer to the former Act at all.*”

Citing *In re. Wood’s Estate*⁵ with approval, the Supreme Court, in



Shamrao V. Parulekar v. District Magistrate⁶, held:

“The rule is that when a subsequent Act amends an earlier one in such a way as to incorporate itself, or a part of itself, into the earlier, then the earlier Act must thereafter be read and construed (except where that would lead to a repugnancy, inconsistency or absurdity) as if the altered words had been written into the earlier Act with pen and ink and the old words scored out so that thereafter there is no need to refer to the amending Act at all. This is the rule in England: see Craies on Statute Law, 5th Edn., p. 207; it is the law in America: see Crawford on Statutory Construction, p. 110; and it is the law which the Privy Council applied to India in *Keshoram Poddar v. Nundo Lal Mallick*⁷.”

The Practice Directions have, therefore, to be treated as part of the Original Side Rules, partaking of their sanctity, and not as a mere appendage thereto.

21. Rule 1(1)(a) in Chapter IV of the Original Side Rules is statutorily made *subject to* Annexure C, i.e. to the Practice Directions. A provision which is “subject to” another is statutorily subservient to the latter. “Subject to” was held, in *Ashok Leyland Ltd v. State of T.N.*⁸, to be “an expression whereby limitation is expressed”. The decision goes on to borrow, in para 93, the definition of “subject to”, as contained in Black’s Law Dictionary, 5th Edn, thus:

“93. In Black’s Law Dictionary, 5th Edn., at p. 1278, the expression “subject to” has been defined as under:

“Liable, subordinate, subservient, inferior, obedient to; governed or affected by; provided that; provided; answerable for. *Homan v. Employers Reinsurance Corpn.*⁹”

⁵ (1886) 31 Ch D 607

⁶ AIR 1952 SC 324

⁷ (1926-27) 54 IA 152 (PC), 155

⁸ (2004) 3 SCC 1

⁹ 345 Mo 650, 136 SW 2d 289, 302



In the context of Sections 107 and 110 of the Karnataka Land Reforms Act, 1961, the Supreme Court, in *K.T. Plantation (P) Ltd v. State of Karnataka*¹⁰, observed:

“64. Section 110 of the Land Reforms Act empowers the State Government to withdraw the exemption granted to any land referred to in Sections 107 and 108. Section 107 itself has been made “subject to” Section 110 of the Act. *The words “subject to” conveys the idea of a provision yielding place to another provision or other provisions to which it is made subject.*

65. In Black's Law Dictionary, 5th Edn. at p. 1278, the expression “subject to” has been defined as under:

“*Subject to.*—Liable, subordinate, subservient, inferior, obedient to; governed or effected by; provided that; provided; answerable for.”

66. *Since Section 107 is made subject to Section 110, the former section conveys the idea of yielding to the provision to which it is made subject that is Section 110 which is the will of the legislature.* Reference may be made to the decisions of this Court in *Punjab Sikh Regular Motor Service v. RTA*¹¹, *Joginder Singh v. Custodian General of Evacuee Property*¹², *Bharat Hari Singhania v. CWT*¹³, *Ashok Leyland Ltd. v. State of T.N.*¹⁴, *Printers (Mysore) Ltd. v. M.A. Rasheed*¹⁵, *South India Corpn. (P) Ltd. v. Board of Revenue*¹⁶, *CWT v. Trustees of H.E.H. Nizam's Family*¹⁷ and *Chandavarkar Sita Ratna Rao v. Ashalata S. Guram*¹⁸.”

(Emphasis supplied)

22. By making Rule 1(1)(a) in Chapter IV of the Original Side Rules subject to Annexure C thereto, the requirement of physical presentation of petitions, complaints, and the like, at the counter of the Registry of this Court has to yield place to the provision of E-filing,

¹⁰ (2011) 9 SCC 1

¹¹ AIR 1966 SC 1318

¹² AIR 1967 SC 145

¹³ 1994 Supp (3) SCC 46

¹⁴ (2004) 3 SCC 1

¹⁵ (2004) 4 SCC 460

¹⁶ AIR 1964 SC 207

¹⁷ (1977) 3 SCC 362 : 1977 SCC (Tax) 457

¹⁸ (1986) 4 SCC 447



and the Practice Directions with respect thereto, where the litigant chooses to file the proceeding electronically. This is also eminently in sync with the aim at fostering and promoting electronic presentation of pleadings, and the harvesting of a healthy e-culture, which would also, in turn, have valuable positive environmental sequelae.

23. Resultantly, electronic filing of pleadings, in accordance with the Practice Directions, would also constitute “presentation” thereof.

24. Clause 10 of the Practice Directions, with its sub clauses read thus:

“10. COMPUTATION OF TIME

10.1 *Electronic filing through the e-filing centre is permissible up to 4 p.m. on the date of filing.* All other rules relating to holidays etc. for the purpose of computation of limitation, as specified in the Rules of the High Court of Delhi will apply to online electronic filing as well. The period during which e-filing system is in-operational for any reason will be excluded from the computation of such time. This, however, will not extend limitation for such filing for which the facility of Section 5 of the Limitation Act, 1963 or any other statutory extension of period of limitation is not available.

10.2 For electronic filing done through the e-filing centre in the Delhi High Court premises, the rules relating to time for the purpose of limitation will be no different from those applicable for the normal filing.

10.3 *As and when the facility of electronic online filing commences, such electronic online filing would be permissible up to midnight on the date of filing.”*

(Emphasis supplied)

25. A reading of Clause 10 of the Practice Directions, with its various sub-clauses, reveals that, while the date when the petition is



uploaded electronically is the date of filing, all other stipulations regarding holidays, dates when the date of e-filing system is non-operational etc. would apply insofar as computation of limitation and other associated stipulations regarding periods of time are concerned. The opening sentence in Clause 10.1, however, is clear and categorical in ordaining that the date of filing is the date of electronic filing and such electronic filing can take place upto 4 p.m. on every day when it is possible.

26. Presentation of a petition, in the case of electronic filing has necessarily to mean uploading of the petition through the e-filing facility available and provided with this Court. Clause 10.3 of the Practice Directions clarifies that, as and then the facility of electronic online filing commences, electronic online filing would be permissible up to midnight *on the date of filing*. In the present case, the revocation petition was apparently uploaded electronically by the petitioner at about 12:05 pm on 16 October 2021. Seen in the backdrop of the electronic filing protocol envisaged by the sub-clauses of Clause 10 of the Practice Directions contained in Annexure (C) to the Original Side Rules, in conjunction with Rule 1(1)(a) in Chapter IV thereof, it cannot but be held that the petition was filed and, therefore, “presented” within the meaning of Order IV Rule 1(1) of the CPC on 16 October 2021.

27. Thus, the Court is of the view that the institution of the present revocation petition has to be regarded as prior in point of time to the institution, by Boehringer, of COMS 5/2021 before the High Court of



Himachal Pradesh.

II. Is a revocation petition a “suit” for the purposes of Section 10 of the CPC?

28. Though the present application has to fail even on the above reasoning, as the suit before the Himachal Pradesh High Court was instituted later in point of time to the present revocation petition, I deem it appropriate, in view of the extensive arguments advanced on the issue, to address what is actually the first issue for consideration in the present case, which is whether a revocation petition can be treated as a “suit” for the purposes of Section 10 of the CPC.

29. Though it is generally understood that the CPC does not define the expression “suit”, an indirect definition of the expression is actually to be found in Order IV Rule 1(1) of the CPC. Order IV Rule 1(1) may, read differently, be understood as stipulating that a suit is a plaint which is presented to a Court or to the officer appointed by the Court in that behalf. Presentation of a plaint in the Court or to the duly appointed officer, therefore, brings into existence a “suit” within the meaning of the CPC.

30. The questions of whether a proceeding which is, *stricto sensu*, not a plaint as instituted under the CPC, would qualify as a “suit”, has come up for consideration before the Supreme Court on various occasions.



31. In *Patel Roadways Ltd. v. Birla Yamaha Ltd.*¹⁹, the Supreme Court was concerned with whether a complaint, instituted before the National Consumer Disputes Redressal Commission, (NCDRC) could be treated as a “suit”. The issue, however, arose in the context of Section 9 of the Carriers Act, 1865, which reads thus:

“9. In any suit brought against a common carrier for the loss, damage or non-delivery of goods (including containers, pallets or similar articles of transport used to consolidate goods) entrusted to him for carriage, it shall not be necessary for the plaintiff to prove that such loss, damage or non-delivery was owing to the negligence or criminal act of the carrier, his servants or agents.”

32. Explaining the ambit of the expression “suit”, for the purposes of Section 9 of the Carriers Act, the Supreme Court ruled as under:

“48. ... The term “suit” has not been defined in the Carriers Act nor is it provided in the said Act that the term “suit” will have the same meaning as in the Civil Procedure Code. Therefore, the ordinary dictionary meaning of the term will have to be taken for ascertaining its meaning. In P. Ramanatha Aiyar's Law Lexicon, 1997 Edn., some of the references of the term are:

“Suit. – Prosecution or pursuit of some claim, demand or request; the act of suing, the process by which one endeavours to gain an end or object; attempt to attain a certain result; the act of suing; the process by which one gains an end or object, an action or process for the recovery of a right or claim; the prosecution of some demand in a court of justice; any proceeding in a court of justice in which plaintiff pursues his remedy to recover a right or claim; the mode and manner adopted by law to redress civil injuries; a proceeding in a court of justice for the enforcement of a right.

The word ‘suit’ in Sections 51 to 55 Act IX of 1879, Court of Wards Act, does not mean only what is usually called a ‘regular suit’. It embraces all contentious proceedings of

¹⁹ (2000) 4 SCC 91



an ordinary civil kind, whether they arise in a suit or miscellaneous proceedings.”

Suit, Action.—‘Suit’ is a term of wider signification than action; it may include proceedings on a petition.”

49. From the above it is clear that the term “suit” is a generic term taking within its sweep all proceedings initiated by a party for realisation of a right vested in him under law. The meaning of the term “suit” also depends on the context of its user which in turn, amongst other things, depends on the Act or the rule in which it is used. No doubt the proceeding before a National Commission is ordinarily a summary proceeding and in an appropriate case where the Commission feels that the issues raised by the parties are too contentious to be decided in a summary proceeding it may refer the parties to a civil court. That does not mean that the proceeding before the Commission is to be decided ignoring the express statutory provisions of the Carriers Act (Section 9) in a proceeding in which a claim is made against a common carrier as defined in the said Act. Accepting such a contention would defeat the object and purpose for which the Consumer Protection Act was enacted. A proceeding before the National Commission, in our considered view, comes within the term “suit”. Accordingly we reject the contention raised by Shri Ashok Desai in this regard.”

33. The decision in *Patel Roadways*¹⁹, was subsequently followed by the Supreme Court in *Ethiopian Airlines v. Ganesh Narain Sahu*²⁰.

34. The position that emerges when one reads *Patel Roadways*¹⁹ is that, while the general definition understanding of the expression “suit” – on which Mr. Aggarwal also placed reliance – is of significance, much would turn on the statutory provision in which the expression is used and which comes up for consideration before the Court. In the case of *Patel Roadways*¹⁹, as well as in *Ethiopian Airlines*²⁰, the expression “suit” was to be understood not in the context of any provision in the CPC, but in the context of other

²⁰ (2011) 8 SCC 539



statutes which used the expression.

35. Even in the case of such other statutes, the Supreme Court, in a later decision in *Inderjeet Arya v. ICICI Bank Limited*²¹, expressed the opinion, following its earlier decision in *Nahar Industrial Enterprises Ltd. v. Hong Kong and Shanghai Banking Corpn*²² that the expression “suit”, in the context of Section 22(1) of the Sick Industrial Companies (Special Provisions) Act 1985, had to be understood as a suit as filed under the Civil Procedure Code and not any original proceedings before any legal forum. In *Inderjeet Arya*²¹, the Supreme Court categorically held that the term “suit” would apply only to proceedings in Civil Courts and not actions or recovery proceedings filed by banks and financial institutions before a Tribunal such as the Debt Recovery Tribunal.

36. A judgment which is much more akin to the controversy at hand is the decision of the Supreme Court in *Raju Jhurani v. Germinda Private Ltd*²³. The contention that was sought to be raised before the Supreme Court in that case was that Order II Rule 2 of the CPC should be applicable to a winding up proceeding instituted under Sections 433, 434 and 439 of the Companies Act, 1956, treating such a proceeding as a “suit” for the purposes of Order II Rule 2. The Supreme Court, categorically and unequivocally rejected the submission, thus, in para 12 of the report:

²¹ 2014 2 SCC 229

²² 2009 8 SCC 646

²³ 2012 8 SCC 563



“12. Having considered the submissions made on behalf of the respective parties, we are inclined to accept Ms Shobha’s submissions as far as the provisions of Order 2 Rule 2 CPC are concerned. Order 2 CPC deals with the frame of suits and the various rules contained therein also refer to suits for obtaining the reliefs of a civil nature. On the other hand, *a proceeding under Sections 433, 434 and 439 of the Companies Act, 1956, is not a suit, but a petition which does not attract the provisions of Order 2 Rule 2 CPC, which deals with suits.*”

(Emphasis supplied)

37. *Raju Jhurani*²³, therefore, is an authority for the proposition that, where provisions of the CPC which deal with suits are sought to be invoked with respect to proceedings instituted under other statutes, such proceedings are not to be treated as suits. The reasoning of the Court in *Raju Jhurani*²³, while dealing with Order II Rule 2²⁴ can easily be extrapolated to the present dispute, in which Boehringer seeks to urge that a revocation petition, instituted under Section 64 of the Patents Act, should be treated as a “suit” for the purposes of Section 10 of the CPC. Borrowing the proverbial leaf from *Raju Jhurani*²³, if a winding up proceeding under Sections 433 and 434 of the Companies Act is not to be treated as a suit for the purposes of Order II Rule 2 of the CPC, equally, there is no reason to treat a revocation proceeding, under Section 64 of the Patents Act, as a suit for the purposes of Section 10 of the CPC.

²⁴ 2. **Suit to include the whole claim.** –

(1) Every suit shall include the whole of the claim which the plaintiff is entitled to make in respect of the cause of action; but a plaintiff may relinquish any portion of his claim in order to bring the suit within the jurisdiction of any Court.

(2) *Relinquishment of part of claim.* – Where a plaintiff omits to sue in respect of, or intentionally relinquishes, any portion of his claim, he shall not afterwards sue in respect of the portion so omitted or relinquished.

(3) *Omission to sue for one of several reliefs.* – A person entitled to more than one relief in respect of the same cause of action may sue for all or any of such reliefs; but if he omits, except with the leave of the Court, to sue for all such reliefs, he shall not afterwards sue for any relief so omitted.



38. Mr. Aggarwal has not been able to draw my attention to any provision which either in the CPC or in any of the rules governing this Court including the IPD Rules and the Patent Rules, which, either expressly or by necessary implication, treats a revocation petition under Section 64 of the Patents Act as a suit for the purposes of Section 10 of the CPC. He has sought to contend, in this context, that

- (i) the petitioners have, in prayer (b) of the petition, sought a decree, which can only be obtained in a duly instituted suit, for which purpose he relies on Section 2(2)²⁵ of the CPC,
- (ii) Section 2(1)²⁶ of the Limitation Act holds that the expression “suit” does not include an appeal or an application whereas all other pleadings are suits,
- (iii) Rule 2(b) of the High Court of Delhi Rules Governing Patent Suits, 2022 (“the Patent Rules”) which defines “patent suits” as meaning “all suits which seek reliefs as provided for under Section 48, Sections 105, 106 including counter claims under Section 64, Section 108, 109, 114 and all reliefs claimed thereunder”, and
- (iv) The fact that certain other High Courts have treated revocation petitions as suits and have, in some cases, even converted revocation petitions to suits.

Explanation. – For the purposes of this rule an obligation and a collateral security for its performance and successive claims arising under the same obligation shall be deemed respectively to constitute but one cause of action.

²⁵ (2) “decree” means the formal expression of an adjudication which, so far as regards the Court expressing it, conclusively determines the rights of the parties with regard to all or any of the matters in controversy in the suit and may be either preliminary or final. It shall be deemed to include the rejection of a plaint and the determination of any question within Section 144, but shall not include –

- (a) any adjudication from which an appeal lies as an appeal from an order, or
- (b) any order of dismissal for default.

²⁶ 2. **Definitions.** – In this Act, unless the context otherwise requires, -



39. None of these submissions, quite obviously, can determine the issue of whether a revocation petition, instituted before this Court under Section 64 of the Patents Act, can be treated as a suit for the purposes of Section 10 of the CPC. Apropos prayer (b) in the revocation petition, the mere fact that the petitioner may have sought a decree cannot convert the revocation petition into a suit. It may be open to the respondent to question as to whether such a decree could be granted in a revocation petition; that, however, is not an issue on which I venture to express any view at this point of time. Section 2(l) of the Limitation Act is no more than a definition clause, limited to defining the expression “suit” for the purposes of the Limitation Act. It has, therefore, no applicability outside the peripheries of the Limitation Act.

40. Though, as in the case of the E-Filing Rules, the Patent Rules, which were notified *vide* Notification dated 24 February 2022, would not, *stricto sensu*, apply, nonetheless, even if they were to be taken as applicable, Rule 2(b) of the Patent Rules, in fact, militates *against* the stand canvassed by Mr Aggarwal, as it specifically treats only *counter claims filed in patent suits, under Section 64*, as “suits”. Applying the maxim *expresso unius est exclusion alterius*²⁷, the Rule, by implication, *excludes*, from the ambit of the expression “patent suit”, all other species of challenges to a patent, envisaged by Section 64 – including a revocation petition – other than a counter-claim in an instituted infringement suit.

(l) “suit” does not include an appeal or an application;

²⁷ “The expression of one thing is the exclusion of the other.”



41. In the absence of any provision by which a revocation petition under Section 64 of the Patents Act can be treated as a suit, a Court cannot deem a revocation petition to be a suit. Deeming fictions, and the creation of deeming fictions, are generally the exclusive province of the legislature. If a legislature creates a deeming fiction, then the principle laid down by Lord Asquith in *East End Dwellings Ltd v. Finsbury Borough Council*²⁸ would apply and the Court would deem all sequelae to the deeming fictions to also follow from the creation of the fiction itself. The Court cannot, however, create a deeming fiction on its own, where the statute does not do so. In the absence, therefore, of any provision which deems a revocation petition under Section 64 of the Patents Act to be a suit, a Court cannot, even in the interests of expediency, so hold.

42. There is one final reason why the revocation petition cannot be treated as a suit for the purposes of Section 10 of the CPC. Section 10 does not bring to a halt the proceedings in a suit, even if it applies in the facts of a particular case. It only stays the trial of the suit. It is well settled that, even in a case where Section 10 applies, the Court which is seized of the later suit may still pass interlocutory orders under Order XXXIX of the CPC and other cognate provisions. All that is stayed is the trial of the suit.

43. In this background, I specifically queried of Mr. Aggarwal as to when in a revocation proceeding, the trial could be said to commence.

²⁸ **1952 AC 109**, in which it was held: “If you are bidden to treat an imaginary state of affairs as real, you must surely, unless prohibited from doing so, also imagine as real the consequences and incidents which, if the putative state of affairs had in fact existed, must inevitably have flowed from or accompanied it.”



Though Mr Aggarwal did not venture any direct answer on the point, he did point out that trial is not entirely foreign to revocation petitions as, in certain cases, the Court may deem it necessary to conduct a trial even in revocation petitions. That, however, would result in a situation in which revocation petitions which are subjected to trial would become subject to Section 10 and revocation petitions which are decided without a trial would not be amenable to Section 10. That, quite obviously, cannot be the legal position.

44. In these circumstances, therefore, the first issue which arises for consideration, which is whether a revocation petition can be treated as a suit for the purposes of Section 10 of the CPC, has also necessarily to be answered in negative. In other words, in my considered opinion, a revocation petition under Section 64 of the Patents Act is not a suit within the meaning of Section 10 of the CPC.

45. For this reason, too, therefore, the present application must fail.

III. Is a case for stay made out even on merits?

46. Though, in the view of the above discussion, the issue of merits of the revocation petition does not really arise for consideration, I may only note, in this context, the judgment of the Supreme Court in *Aspi Jal v. Khushroo Rustom Dadyburjor*²⁹, in which the Supreme Court has expounded on the circumstances in which Section 10 of the CPC would apply. The relevant passages from the said decision read thus:

²⁹ (2013 4 SCC 333



“9. Section 10 of the Code which is relevant for the purpose reads as follows:

“**10. Stay of suit.** – No court shall proceed with the trial of any suit in which the matter in issue is also directly and substantially in issue in a previously instituted suit between the same parties, or between parties under whom they or any of them claim litigating under the same title where such suit is pending in the same or any other court in India having jurisdiction to grant the relief claimed, or in any court beyond the limits of India established or continued by the Central Government and having like jurisdiction, or before the Supreme Court.

Explanation. – The pendency of a suit in a foreign court does not preclude the courts in India from trying a suit founded on the same cause of action.”

From a plain reading of the aforesaid provision, it is evident that where a suit is instituted in a court to which provisions of the Code apply, it shall not proceed with the trial of another suit in which the matter in issue is also directly and substantially in issue in a previously instituted suit between the same parties. For application of the provisions of Section 10 of the Code, it is further required that the Court in which the previous suit is pending is competent to grant the relief claimed. The use of negative expression in Section 10 i.e. “no court shall proceed with the trial of any suit” makes the provision mandatory and the court in which the subsequent suit has been filed is prohibited from proceeding with the trial of that suit if the conditions laid down in Section 10 of the Code are satisfied. The basic purpose and the underlying object of Section 10 of the Code is to prevent the courts of concurrent jurisdiction from simultaneously entertaining and adjudicating upon two parallel litigations *in respect of same cause of action, same subject-matter and the same relief*. This is to pin down the plaintiff to one litigation so as to avoid the possibility of contradictory verdicts by two courts *in respect of the same relief* and is aimed to protect the defendant from multiplicity of proceeding.

10. The view which we have taken finds support from a decision of this Court in *National Institute of Mental Health & Neuro Sciences v. C. Parameshwara*³⁰ in which it has been held as follows:

³⁰ (2005) 2 SCC 256



“8. The object underlying Section 10 is to prevent courts of concurrent jurisdiction from simultaneously trying two parallel suits in respect of the same matter in issue. The object underlying Section 10 is to avoid two parallel trials on the same issue by two courts and to avoid recording of conflicting findings on issues which are directly and substantially in issue in previously instituted suit. The language of Section 10 suggests that it is referable to a suit instituted in the civil court and it cannot apply to proceedings of other nature instituted under any other statute. The object of Section 10 is to prevent courts of concurrent jurisdiction from simultaneously trying two parallel suits between the same parties in respect of the same matter in issue. The fundamental test to attract Section 10 is, whether on final decision being reached in the previous suit, such decision would operate as res judicata in the subsequent suit. *Section 10 applies only in cases where the whole of the subject-matter in both the suits is identical.* The key words in Section 10 are ‘the matter in issue is directly and substantially in issue’ in the previous instituted suit. The words ‘directly and substantially in issue’ are used in contradistinction to the words ‘incidentally or collaterally in issue’. Therefore, Section 10 would apply only if there is identity of the matter in issue in both the suits, meaning thereby, that the whole of the subject-matter in both the proceedings is identical.”

11. In the present case, the parties in all the three suits are one and the same and the court in which the first two suits have been instituted is competent to grant the relief claimed in the third suit. The only question which invites our adjudication is as to whether “the matter in issue is also directly and substantially in issue in previously instituted suits”. The key words in Section 10 are “the matter in issue is directly and substantially in issue in a previously instituted suit”. The test for applicability of Section 10 of the Code is whether on a final decision being reached in the previously instituted suit, such decision would operate as res judicata in the subsequent suit. To put it differently one may ask, can the plaintiff get the same relief in the subsequent suit, if the earlier suit has been dismissed? In our opinion, if the answer is in the affirmative, the subsequent suit is not fit to be stayed. However, we hasten to add then when the matter in controversy is the same, it is immaterial what further relief is claimed in the subsequent suit.

12. As observed earlier, for application of Section 10 of the Code, the matter in issue in both the suits have to be directly and



substantially in issue in the previous suit but the question is what “the matter in issue” exactly means? As in the present case, many of the matters in issue are common, including the issue as to whether the plaintiffs are entitled to recovery of possession of the suit premises, but for application of Section 10 of the Code, *the entire subject-matter of the two suits must be the same. This provision will not apply where a few of the matters in issue are common and will apply only when the entire subject-matter in controversy is same. In other words, the matter in issue is not equivalent to any of the questions in issue.* As stated earlier, the eviction in the third suit has been sought on the ground of non-user for six months prior to the institution of that suit. It has also been sought in the earlier two suits on the same ground of non-user but for a different period. Though the ground of eviction in the two suits was similar, the same were based on different causes. The plaintiffs may or may not be able to establish the ground of non-user in the earlier two suits, but if they establish the ground of non-user for a period of six months prior to the institution of the third suit that may entitle them the decree for eviction. Therefore, in our opinion, the provisions of Section 10 of the Code is not attracted in the facts and circumstances of the case.”

(Emphasis supplied)

47. Viewed in the backdrop of these aforesaid passages, it is clear that it is only where there is complete equality of the issues in consideration and of the causes of action and the relief sought in two proceedings that the later proceeding can be stayed under Section 10 CPC. Mr. Sai Deepak is correct in his contention that there is a fundamental difference between a proceeding for revocation of a patent under Section 64 of the Patents Act and a civil suit by a patent holder, seeking injunction against infringement of the patent under Section 104 of the Patents Act. One fundamental difference between the two proceedings is that, if a revocation proceeding succeeds, the patent is effaced from the register of patents. On the other hand, insofar as an infringement suit is concerned, the challenge to the validity of a patent is only one of the defences which can be taken



under Section 107(1)³¹ of the Patents Act as a ground against a charge of infringement, to avoid an injunction. Even if the ground is accepted, the patent does not stand extinguished. The only result is that the injunction sought would not be granted.

48. As such, even the relief which would result, in the event of the challenge to the patent, in the revocation proceedings and in the written statement filed by way of response to the suit, succeeding, is completely different.

49. Tested on the touchstone of *Aspi Jal*²⁹ and *C. Parameshwara*³⁰, therefore, it cannot be said that, even on merits, any case exists for staying the present revocation petition pending the outcome of the suit instituted in the High Court of Himachal Pradesh.

50. For all the aforesaid reasons, the present application under Section 10 of the CPC fails and is dismissed.

C.O.(COMM.IPD-PAT) 3/2021, I.A. 13644/2021 (under Order XXXIX Rules 1 and 2 of the CPC) & I.A. 5878/2023 (under Section 151 of the CPC)

51. Re-notify on 24 August 2023.

C.HARI SHANKAR, J

AUGUST 3, 2023

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³¹ 107. **Defences, etc. in suits for infringement.** –

(1) In any suit for infringement of a patent, every ground on which it may be revoked under Section 64 shall be available as a ground for defence.